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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,336	04/19/2004	Joseph Chisari		3453

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EXAMINER

SANTOS, ROBERT G

ART UNIT PAPER NUMBER

3673

DATE MAILED: 09/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/693,336

Applicant(s)

CHISARI, JOSEPH

Examiner

Robert G. Santos

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3673

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2-7 and 9-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 19 is/are allowed.
- 6) ☒ Claim(s) 2-7 and 9-16 is/are rejected.
- 7) ☒ Claim(s) 17 and 18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |                                                                                         |                                                                             |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                                |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____                                                             | 6) <input type="checkbox"/> Other: _____                                    |

*hcl*

**DETAILED ACTION*****Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 2, 2005 has been entered.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 2-7 and 9-13 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 3,811,140 to Burpo. Burpo '140 is considered to show the *structural* limitations of a device (10) comprising a wedge-shaped head piece (11) and a wedge-shaped torso piece (11a) each formed by a flat base (14, 14a) and a support surface having a transverse slope, wherein the head and torso pieces are both deployable on a sleep surface and each comprise a block (13, 13a) of hard, non-yielding material (as described in column 2, lines 4-6), a cover (21, 21a) fitted tightly over the block (as shown in Figure 3), and a soft and compressible pillow (23, 23a) enveloping both the block and

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cover (also as shown in Figure 3). Moreover, the claimed recitations regarding the positioning of a person relative to the device (such as those recited in claims 4 and 7) are considered to be method steps which do not have patentable weight in apparatus claims.

4. Claims 2-7, 9 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 4,171,549 to Morrell et al. Morrell et al. '549 are considered to show the *structural* limitations of a device (2) comprising a wedge-shaped head piece (30) and a wedge-shaped torso piece (10) each formed by a flat base (35, 15) and a support surface (36, 16) having a transverse slope, wherein the head and torso pieces are both deployable on a sleep surface and the head piece comprises a head block (56), a head-block cover (59a) fitted tightly over the block and a pillow (59b) enveloping the block and cover. Furthermore, the claimed recitations regarding the positioning of a person relative to the device (such as those recited in claims 4 and 7) are considered to be method steps which do not have patentable weight in apparatus claims.

5. Claims 2-7, 15 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 6,009,873 to Neviaser. Neviaser '873 is considered to show the *structural* limitations of a sleep-support system comprising a torso piece (400) and a head piece (410); wherein the head piece has a head-piece wedge shape formed by a flat base and a head-support surface (430) having a transverse slope that is determined by a head-piece wedge angle, the head-support surface having a high end and a low end (as shown in Figure 4 and as described in column 6, lines 63-65); wherein the torso piece has a torso-piece wedge shape formed by a flat base and a torso-support surface having a transverse

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slope that is determined by a torso-piece wedge angle (as shown in Figure 4 and as described in column 6, lines 65-66), the torso-support surface having a high end and a lower end; further wherein the head and torso pieces are both deployable on a sleep surface; and the high end of the head-support surface being a height that is at least twice the height of the high end of the torso-support surface (as shown in Figure 4). Moreover, the claimed recitations regarding the positioning of a person relative to the device (such as those recited in claims 4 and 7) are considered to be method steps which do not have patentable weight in apparatus claims. With regards to claim 16, the reference discloses a condition wherein the head-wedge angle is approximately 60 degrees (see Figure 2 and column 5, lines 53-54).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Burpo '140, or alternatively, as being unpatentable over Morrell et al. '549. Burpo '140 and Morrell et al. '549 do not specifically disclose a condition wherein the head block (13, 56) is in cross section of an isosceles triangle. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the respective sleep-support systems of Burpo '140 and Morrell et al. '549 with a head block having the cross section of an isosceles triangle, since it has been held that discovering an optimum

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value of a result effective variable involves only routine skill in the art. *In re Boesch*, 67 F.2d 272, 205 USPQ 215 (CCPA 1980).

### ***Response to Amendment***

In response to Applicant's arguments on pages 11 and 12 of his amendment concerning the Ferguson '419 reference, the examiner respectfully agrees. Hence, the claim rejections under Ferguson '419 have been respectfully withdrawn.

Furthermore, in response to Applicant's arguments on page 12 of his amendment regarding the Burpo '140 patent, the examiner respectfully maintains that the device of Burpo '140 is inherently capable of being positioned relative to a person as recited in Applicant's apparatus claims and is therefore still considered to meet all of the limitations as recited in these claims.

### ***Allowable Subject Matter***

8. Claims 17 and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The examiner respectfully asserts that one of ordinary skill in the art would not have found it obvious at the time the invention was made to modify each of the *inflatable* wedges (400, 410) of the sleep-support system of Neviaser '873 to include a block made of rigid material and a cover that covers the support surface of each wedge with a compressible cushioning material, as particularly recited in claims 17 and 18.

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9. Claim 19 is allowed. The examiner respectfully asserts that none of the prior art, taken either singly or in combination, is seen to teach or suggest a method of supporting a prone sleeper comprising the step of placing on a bed surface a cylindrical torso piece having a wedge-shaped cross section perpendicular to a torso-piece longitudinal axis and a cylindrical head piece having a wedge-shaped cross section perpendicular to a head-piece longitudinal axis with the thin side of the head piece facing the thin side of the torso piece *in combination with* the step of slipping the head piece upwards with respect to a sleeper then between the bed surface and head of the sleeper such that the head of the sleeper faces the thin side of the head piece as particularly recited therein. As shown by the prior art, most support devices comprising a pair of wedge-shaped pieces are attached together such that they are simply placed on a bed in fixed relation to each other and support only the front and back portions of the torso of a sleeper resting on one side.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Weiss-Lohrei '201, DuDonis '358, Lund, III '052, Sorrell '133, Leto et al. '725 and Dine et al. '080.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert G. Santos whose telephone number is (571) 272-7048. The examiner can normally be reached on Tues-Fr and first Mondays, 10:30 a.m. to 8:00 p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather C. Shackelford can be reached on (571) 272-7049. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Robert G. Santos  
Primary Examiner  
Art Unit 3673

R.S.  
September 13, 2005